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OFFICE OF PETITIONS

In re Application of	:	
Mark Herrmann et al.	:	
Application No. 09/599,675	:	
Filed: June 22, 2000	:	DECISION ON PETITION
Attorney Docket Number: 10984-	:	PURSUANT TO
287001	:	37 C.F.R. § 1.181(A)
Title: CAPTURING ADVERTISING	:	
REQUESTS FROM A USER	:	

This is a decision on the petition pursuant to 37 C.F.R. § 1.181(a) to withdraw the holding of abandonment, filed on January 24, 2008.

The petition is **DISMISSED**.

Background

The above-identified application became abandoned for failure to submit the issue fee in a timely manner in reply to the Notice of Allowance and Issue Fee Due (notice), mailed October 5, 2007, which set a shortened statutory period for reply of three months. No extensions of time are permitted for transmitting issue fees¹. Accordingly, the above-identified application became abandoned on January 6, 2008.

With this petition, Petitioner has asserted that the notice was not received, and has included the issue and publication² fees, a declaration of facts from the Docketing Supervisor/Senior Docketing Specialist, and a copy of an electronic log.

¹ See M.P.E.P. § 710.02(e).

² The publication fee is not required. This fee will be refunded to Petitioner's Deposit Account in due course.

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RELEVANT PORTION OF THE M.P.E.P.M.P.E.P. § 711.03(c) sets forth, *in pertinent part*:

PETITION TO WITHDRAW HOLDING OF ABANDONMENT BASED ON FAILURE TO RECEIVE OFFICE ACTION

In *Delgar v. Schulyer*, 172 USPQ 513 (D.D.C. 1971), the court decided that the Office should mail a new Notice of Allowance in view of the evidence presented in support of the contention that the applicant's representative did not receive the original Notice of Allowance. Under the reasoning of *Delgar*, an allegation that an Office action was never received may be considered in a petition to withdraw the holding of abandonment. If adequately supported, the Office may grant the petition to withdraw the holding of abandonment and remail the Office action. That is, the reasoning of *Delgar* is applicable regardless of whether an application is held abandoned for failure to timely pay the issue fee (35 U.S.C. 151) or for failure to prosecute (35 U.S.C. 133).

To minimize costs and burdens to practitioners and the Office, the Office has modified the showing required to establish nonreceipt of an Office action. The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. For example, if a three month period for reply was set in the nonreceived Office action, a copy of the docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action. See Notice entitled "Withdrawing the Holding of Abandonment When Office Actions Are Not Received," 1156 O.G. 53 (November 16, 1993).

The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office action may have been lost after receipt rather than a conclusion that the Office action was lost in the mail (e.g., if the practitioner has a history of not receiving Office actions).

Evidence of nonreceipt of an Office communication or action (e.g., Notice of Abandonment or an advisory action) other than that action to which reply was required to avoid abandonment would not warrant withdrawal of the holding of abandonment. Abandonment takes place by operation of law for failure to reply to an Office action or timely pay the issue fee, not by operation of the mailing of a Notice of Abandonment. See *Lorenz v. Finkl*, 333 F.2d 885, 889-90, 142 USPQ 26, 29-30 (CCPA 1964); *Krahn v. Commissioner*, 15 USPQ2d 1823, 1824 (E.D. Va 1990); *In re Application of Fischer*, 6 USPQ2d 1573, 1574 (Comm'r Pat. 1988).

Two additional procedures are available for reviving an application that has become abandoned due to a failure to reply to an Office Action: (1) a petition under 37 CFR 1.137(a) based upon unavoidable delay; and (2) a petition under 37 CFR 1.137(b) based on unintentional delay.

Analysis

The showing in this petition is not sufficient to withdraw the holding of abandonment.

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Petitioner has set forth that the notice was not received. Petitioner has attested to the fact that a search of the file jacket and docket records indicates that the Office communication was not received, and has included a portion of the docket record where the nonreceived Office communication would have been entered had it been received and docketed.

First, the notice was mailed to the address of record, which is Fish & Richardson's Minneapolis office. Petitioner is located in Boston³, and as such, it does not appear that Petitioner's file jacket, docket printout, and electronic log can establish that this communication was not received from the Office, since the Office did not mail the notice to Petitioner.

Secondly, *assuming arguendo* that these items could establish that his communication was not received from the Office, Petitioner's showing is incomplete. The declaration of facts makes reference to the inclusion of an electronic log (Exhibit A) and a docket printout (Exhibit B). The electronic log has been located in the electronic file, but the docket printout has not.

CONCLUSION

Any reply must be submitted within **TWO MONTHS** from the mail date of this decision. Extensions of time under 37 C.F.R. § 1.136(a) are permitted. The reply should include a cover letter entitled "Renewed Petition pursuant to 37 C.F.R. § 1.181(a)." This is not a final agency action within the meaning of 5 U.S.C § 704.

The renewed petition should indicate in a prominent manner that the attorney handling this matter is Paul Shanowski, and may be submitted by mail⁴, hand-delivery⁵, or facsimile⁶.

Alternatively, Petitioner may wish to consider the submission of a petition pursuant to 37 C.F.R. §§ 1.137(a) and/or (b).

As set forth above, the address listed on the petition differs from the address of record. The application file does not

³ The address that appears below the signature of the Docketing Supervisor/Senior Docketing Specialist makes it clear that she is also located in Boston.

⁴ Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

⁵ Customer Window, Randolph Building, 401 Dulaney Street, Alexandria, VA, 22314.

⁶ (571) 273-8300- please note this is a central facsimile number.

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indicate a change of correspondence address has been filed in this case, although the address given on the petition differs from the address of record. If Petitioner desires to receive future correspondence regarding this application, the change of correspondence address must be submitted. A courtesy copy of this decision will be mailed to Petitioner. However, all future correspondence will be directed to the address of record until such time as appropriate instructions are received to the contrary. Petitioner will not receive future correspondence related to this application unless Change of Correspondence Address, Patent Form (PTO/SB/122) is submitted for the above-identified application. For Petitioner's convenience, a blank Change of Correspondence Address, Patent Form (PTO/SB/122), may be found at <http://www.uspto.gov/web/forms/sb0122.pdf>.

Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225⁷. All other inquiries concerning examination procedures or status of the application should be directed to the Technology Center.

/Paul Shanoski/
Paul Shanoski
Senior Attorney
Office of Petitions

cc: FISH & RICHARDSON PC
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⁷ Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for Petitioner's further action(s).